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In the Supreme Court of the United States

OCTOBER TERM, 1949.

No. .....

THE HYGIENIC PRODUCTS COMPANY,
Petitioner,

vs.

JUDSON DUNAWAY CORPORATION,
Respondent.

PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals
For the First Circuit.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, The Hygienic Products Company, respectfully prays that a writ of certiorari issue to review, in part, the judgment of the United States Court of Appeals for the First Circuit entered December 15, 1949 (R. 285) and reported in 178 F. 2d 461.

A transcript of the record of the case, including proceedings in said Court of Appeals, is furnished herewith in accordance with the Rules of this Court.

SUMMARY AND SHORT STATEMENT.

The Complaint and Subject Matter in Suit.

Petitioner, The Hygienic Products Company, through its Complaint filed May 31, 1947 (R. 2) in the United States District Court for the District of New Hampshire, charged Judson Dunaway Corporation, the defendant, respondent here, with infringement of petitioner's trade-mark registra-

tions of its picture trade-mark, comprising the picture of a maid or woman pouring from a can into a toilet bowl, and also charged defendant with unfair competition in trade, all by defendant's use of certain advertising material asserted to display, in connection with the sale of defendant's like competing goods, infringing and deceptively similar pictorial representations.[1]

For convenience, we have appended to the back cover a folded-in chart upon which we have reproduced the marks appearing in several of petitioner's fully identified registrations, defendant's pictorial representations complained of, and other illustrations which will be referred to later.

Holdings of Lower Courts.

The District Court held in its opinion (R. 216 to 234, reported in 81 F. Supp. 935) that petitioner's picture trademark and the several registrations thereof were valid, that they had been infringed by defendant's pictorial representations appearing on the chart and that defendant was guilty of unfair competition by the use thereof.

The Court of Appeals in its opinion (R. 285, reported in 178 F. 2d 461) held with the District Court as to the issues bearing on the validity of petitioner's picture mark and registrations, but reversed the District Court on the issues of infringement and unfair competition on the ground, in substance, that defendant's accused pictorial

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[1] On June 13, 1947 petitioner filed an amendment to its Complaint (R. 31) charging defendant with infringement by reason of the use of newspaper publications containing the picture of a hand pouring from a can into a water closet bowl. The District Court, as well as the Court of Appeals, upon petitioner's cross-appeal, found that this picture did not infringe upon petitioner's picture mark or registrations and that defendant was not guilty of unfair competition with respect to the same (R. 234, 293). Petitioner does not seek to have this Court review the judgments of the lower courts with respect to defendant's picture of a hand pouring from a can into a water closet bowl.

representations differ in detailed respects from petitioner's and that defendant's advertising, viewed as a whole, does not so closely resemble petitioner's marks as to be likely to confuse the defendant's product with that of petitioner.

Petitioner's History and Activities.

Continuously since April 1911, petitioner has been engaged in manufacturing and selling throughout the United States and foreign countries a powdered chemical compound, also known under its "Sani-Flush" trade-mark, for cleaning by chemical reaction between the compound and water. During that entire period petitioner's compound has been sold for cleaning toilet bowls and since 1922 it has also been sold for cleaning automobile radiators. Petitioner pioneered this industry and has long been a leader in it, notwithstanding that since 1911 it has had well over 100 competitors marketing similar compounds (R. 64, 73, 101, 217).

Upon entering into this business in 1911 petitioner composed the picture of a maid or woman pouring from a can into a water closet bowl as its trade-mark, to indicate the origin of its pioneer product. There is no dispute that petitioner was the very first to adopt and use this picture as a trade-mark for a cleaning compound, or for that matter, for any goods. It is equally well established that petitioner has continuously and exclusively for over 35 years used such trade-mark on and in connection with the sale of its product, as well as in connection with its advertising thereof (R. 64, 70, 99, 100, 217, 221). With respect to petitioner's registered trade-marks and typical examples of illustrations used in its advertising, ready reference may be had to the appended chart.

Petitioner has manufactured and sold over 400,000,000 cans of its product, representing a sales value to the consumer in excess of $80,000,000 (R. 101,218). Its product has been marketed by direct sales and through jobbers to

retail merchants including general stores, grocery stores and drug stores. Petitioner has also continuously exploited its picture trade-mark in its advertising which has been of national scope and has been largely done through the medium of magazines, newspapers, display cards and leaflets (R. 218). Petitioner spent about $8,000,000 in advertising its product, always in connection with its picture trade-mark (R. 76, 218).

Petitioner's business and good will are worth many millions of dollars (R. 83).

For over 35 years since petitioner's adoption of its picture trade-mark, petitioner has always asserted its right to the exclusive use of its picture trade-mark to indicate origin of its products and all violations by others of petitioner's picture trade-mark were discontinued after protest or action taken by petitioner. Petitioner's picture trade-mark has at all times been associated exclusively with petitioner's product and has been recognized and respected by the trade. The trade-mark is of great good will value to petitioner (R. 83, 109, 110, 112, 131, 147, 218, 230).

Defendant's History and Activities.

The defendant, Judson Dunaway Corporation, is comparatively a newcomer in the field as it did not begin to manufacture and sell its product, which is the same as petitioner's, until 1937. The label on defendant's container (Physical Exh. L, R. 94, 274) has continuously displayed a stream of material flowing from the bottom of the letter "i" in the word "Vanish" into a water closet bowl. For approximately ten years defendant competed with petitioner and built up a prosperous business by manufacturing and selling its product under the registered trade-mark "Vanish" without any endeavor to simulate petitioner's picture trade-mark of a maid pouring from a can into a toilet bowl (R. 196, 218, 219, 231). During this first ten years of the sale of its product, defendant published advertisements such

as those reproduced on our chart. Defendant's president admitted that he thought that these were advertising defendant's products as well as defendant could (R. 195, 196). Petitioner made no complaint with respect to the labels on defendant's cans or with respect to this earlier advertising.

During this ten year period defendant's president had full knowledge of petitioner's picture trade-mark and recognized that petitioner had exclusively used that mark and that it was of great value to petitioner (R. 196, 219). Late in 1946 or early in 1947, defendant adopted for use in its advertising the pictorial representation of a woman pouring from a can into a toilet bowl (R. 219).

Defendant's accused representations are reproduced on our chart.

The newspaper advertisement (Exh. E, R. 253, 57) and the display cards (Physical Exh. K, R. 93, 274) do not in any way display defendant's name. The back of defendant's can carries defendant's name but when the can is placed in the opening of the display card defendant's name is not visible to persons looking at the display. The leaflets (Exh. C, R. 248, 249, 57) do not display defendant's name except in very small type on the back page, completely disassociated from the picture complained of.

Defendant's president admitted that defendant "did use the symbol or picture of a girl pouring the product into a toilet bowl in connection with the sale of" defendant's "product in order to increase" defendant's "sales of that product" (R. 197, 198, 231). No attorney was consulted (R. 199).

Products of Parties Are Same and Sold for Same Uses.

Both petitioner's and defendant's products are in powdered form and are sold in cans, carrying different labels and the trade-marks "Sani-Flush" and "Vanish" respectively. There is no dispute that the products are substantially the same and that they are sold for the same

uses. Petitioner has not complained about defendant's labels nor defendant's use of the name "Vanish."

Neither petitioner's nor defendant's product accomplishes the desired cleaning result in water closet bowls or in automobile radiators, except in the presence of water which is essential to produce the necessary chemical cleaning reaction. Petitioner has always and defendant has for years printed explicit directions on their respective containers (Physical Exh. G-1 and L, R. 71, 94, 273, 274) detailing the successive steps which must be taken in order that their products may accomplish their purpose. The directions on defendant's container are quite similar to those which had long appeared on petitioner's, and we quote defendant's directions with respect to cleaning toilet bowls and radiators:

> "TO CLEAN TOILET BOWLS—Flush toilet, then pour VANISH into bowl and around sides in direct contact with discolored parts. Allow to stand until all bubbling stops. With brush or swab, swish off discoloration loosened by VANISH's chemical action. Then flush. For a badly discolored bowl repeat, allowing the solution to remain in bowl 15 mins. or longer." (R. 166.)

> "TO CLEAN AUTO RADIATORS—While radiator is warm and motor running pour in very slowly one-half of this can. Run engine 15 minutes, then drain. For large trucks, use entire can. THOROUGHLY FLUSH WITH CLEAN WATER BEFORE REFILLING. Do not allow to touch paint or finish." (R. 167.)

The text of defendant's leaflet, Exhibit C (R. 248) contains the same instructions for cleaning radiators adjacent the slogan "A HANDY TIP FOR HUSBANDS" (R. 248).

JURISDICTION.

The District Court had jurisdiction under what was at the time the action commenced, Section 24 of the Judicial Code (28 U. S. C. Secs. 41 (1) and 41 (7)), the substance of which is now found in U. S. Code, Title 28, Secs. 1332 and 1338.

With respect to the trade-mark registrations, the pertinent provisions of the Trade-Mark Act of 1905 (15 U. S. C. Secs. 85 and 96) apply rather than the Trade Mark Act of 1946 (15 U. S. C. Secs. 1051-1127), as the latter did not become effective until after the present action was filed.

The jurisdiction of this Court is invoked under Section 1254 of Title 28—United States Code, the date of the judgment sought to be reviewed being December 15, 1949.

QUESTIONS PRESENTED.

1. Are petitioner's valuable good will rights in its unique and distinctive picture trade-mark, first adopted and used exclusively by petitioner for over thirty-five years and registered by it, to be so strictly construed as to entitle petitioner to protection only against "Chinese" copying?

2. Is the defendant guilty of trade-mark infringement by use in connection with the sale of its product, of pictorial representations which have the same essential ensemble and prominent characteristics as petitioner's trade-mark, registered by petitioner and used in its advertising?

3. Is defendant guilty of unfair competition?

4. Were the Findings of the District Court as to infringement and unfair competition by defendant "clearly erroneous"? (Rule 52 (a) of the Rules of Civil Procedure.)

REASONS RELIED UPON FOR THE GRANT OF A WRIT.

1. The questions, and particularly questions 1, 2 and 3, presented by the decision of the Court of Appeals in this action are of great importance to trade-mark owners and to the general public.

2. The precise questions, and particularly questions 1, 2 and 3, presented by the decision of the Court of Appeals in this action have not been specifically passed upon by this Court.

3. There is divergence of views expressed in the opinions below on questions 1, 2 and 3, and the decision of the Court of Appeals on all the questions is in conflict with applicable decisions of this and other Federal Courts.

WHEREFORE, we submit that this Petition for Certiorari to the United States Court of Appeals for the 1st Circuit should be granted.

Respectfully submitted,

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HARRY FREASE,
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FRANK J. SULLOWAY,
RANDOLPH C. RICHARDSON,
Counsel for Petitioner.

Washington, D. C.
March 14, 1950.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

The opinion of the District Court and Court of Appeals below are reported respectively in 81 F. Supp. 935 and 178 F. 2d 461; and the grounds on which jurisdiction of this Court is invoked and a statement of the case appear commencing respectively in pages 7 and 1 of the foregoing Petition.

OPINIONS OF THE COURTS BELOW.

The opinion of the District Court, Judge Connor, will be found at R. 216 and is reported at 81 F. Supp. 935. The opinion was rendered after a full trial and upon briefs and oral arguments. The opinion includes well considered Findings of Fact and Conclusions of Law. The more pertinent facts, set forth in our Petition, are stated even more fully by the District Court in its opinion, and will not be repeated here.

The District Court essentially found that petitioner had adopted its pictorial representation of a woman pouring from a can into a toilet bowl as a unique symbol or device to indicate the origin of its manufacture, that this picture mark and the registrations were not descriptive, as asserted by the defendant, that the registered marks had not been abandoned, as contended by defendant, that there "is ample authority to the effect that leaflets, display cards and newspaper advertising will support a claim of infringement" (citing cases) (R. 228), that there was likelihood of confusion in the trade and that defendant was guilty of trade-mark infringement and unfair competition in trade.

The District Court, after comparing plaintiff's picture mark and the accused picture representations of defendant, said, in part, with respect to the matter of defendant's infringement and unfair competition:

"Thus considered, the advertising material must be characterized as a colorable imitation of the plaintiff's trade-marks. Concededly there are variations, and this would necessarily be so if exact reproduction was to be avoided; but the differences are minor, such as the apparent age and attire of the respective maids. In two of the display cards used by the defendant was a cut-out wherein was placed for display a can of its product, with a large part of the card given over to a picture of a young woman in the act of pouring a can of material into a toilet bowl. Such would readily tend to confuse a prospective customer in the purchase of this type of product." (R. 228)

* * * * *

"Having in mind the test by which the defendant's complained of conduct is to be measured, I am of the opinion that the mode of advertising which the defendant has adopted would likely be misleading and result in consumer confusion, and, as such, was an infringement on the plaintiff's right to the exclusive use of the trade-mark." (R. 229)

* * * * *

"The motive prompting the defendant to use the objected to advertisements was to increase its sales, and hence it could be inferred that it sought to divert some of the plaintiff's trade profits thereby. Both forms of advertising would probably result in consumer confusion, and would differ only in degree, with the display cards containing the insert likely to be the most effective." (R. 231)

* * * * *

"It is difficult to believe that the adoption of this design, so similar to that of the plaintiff, was solely a coincidence, and this despite the defendant's knowledge that the plaintiff had used this symbol for many years."

"In these circumstances, intent may reasonably be inferred." (R. 231)

The opinion of the Court of Appeals will be found at R. 285, and is reported at 178 F. 2d 461. The Court of

Appeals likewise found (R. 290) that petitioner's picture trade-mark and registrations are valid and "are not merely descriptive but are original, arbitrary and fanciful", that none of the registered marks had been abandoned and that it was assumed that one may infringe by advertising matter, citing *Mishawaka R. & W. Mfg. Co. v. Panther-Panco Rub. Co.*, 153 F. 2nd 662.

The Court of Appeals found, however, that the defendant did not infringe and was not guilty of unfair competition, seemingly on the theories that petitioner's trade-mark protection must be strictly confined to the exact form, dress and appearance of the women shown in petitioner's registrations and that defendant's advertisements, unlike petitioner's trade-mark registrations, carry slogans or words and background for its accused illustrations of a woman pouring from a can into a toilet bowl. For convenience we quote here what the Court of Appeals said, in part, on this matter (R. 291):

> "Of course, the defendant cannot represent its product in use in such a setting, or in such a way, as to render it likely that the purchasing public will confuse its product with that of the plaintiff. But this does not mean that the defendant is relegated to advertising its product by showing it in use by an old crone in a mother hubbard with a scowl on her face. Clearly in advertising, to quote from the current musical play 'South Pacific,' 'There is nothing like the frame of a dame,' and we cannot see why the defendant is not as much entitled to take commercial advantage of pulchritude as the plaintiff.
>
> "We mention these matters at some length for it seems to us that the District Court's conclusion of infringement, with which we feel constrained to disagree, could only have rested upon the defendant's use in its advertising of the foregoing elements which we think it was free to use, because, aside from those elements, the defendant's advertising bears little or no resemblance to the plaintiff's marks."

SPECIFICATION OF ERRORS.

The errors which petitioner will urge if the petition for writ of certiorari is granted are that the United States Court of Appeals for the First Circuit erred:

(1) In not affirming the judgment of the District Court that defendant infringed petitioner's picture trade-mark and registrations, comprising the picture of a woman pouring from a can into a toilet bowl.

(2) In not affirming the judgment of the District Court that defendant was guilty of unfair competition by reason of defendant's use of its pictorial representations of a woman pouring from a can into a toilet bowl.

ARGUMENT.

The Argument will follow the "Questions Presented," as stated on page 7 of the Petition.

POINT I.

Petitioner's Valuable Good Will Rights in Its Unique and Distinctive Trade-Mark, First Adopted and Used Exclusively by Petitioner for Over Thirty-Five Years and Registered by It, Should Not Be So Strictly Construed as to Entitle Petitioner to Protection Only Against "Chinese" Copying.

The following essential facts are not only clearly established by the record in this case as we have shown in the petition, but were specifically found by the District Court and recited in large measure by the Court of Appeals in its decision. In 1911 petitioner adopted its picture trade-mark comprising a woman pouring from a can into a toilet bowl. It has sold hundreds of millions of cans of its product having a value of many millions of dollars. The product has been sold for use for cleaning automobile radiators and toilet bowls. Millions of dollars have been

spent by petitioner in nationally advertising its product through virtually all mediums. Its picture representation was adopted with the intent of using it as a trade-mark, and has been exclusively used by petitioner, except for defendant's asserted infringing use. All of petitioner's advertising has displayed a picture of its can with its registered picture trade-mark prominently appearing on the label on the can. Much of defendant's advertising material carried very similar pictorial representations having the same motif, that is, the same essential ensemble of elements and prominent characteristics.

The District Court said, in part:

> "The plaintiff adopted and used a pictorial representation as a unique symbol or device to indicate the origin of the goods of its manufacture and to distinguish them from goods of the same general nature which might be manufactured by others." (R. 221.)

and

> "The long, continued, and exclusive use of the symbol has come to denote origin, and distinguishes the goods of the plaintiff from those of others" * * * (R. 222.)

The Court of Appeals did not quarrel with these findings. In fact it stated that "plaintiff's marks are valid" and are "original, arbitrary and fanciful" (R. 290).

Along with such picture trade-marks as the girl carrying an umbrella and a pouring can for salt, the muscular arm and hammer for baking soda, the "Gold Dust" twins for cleaning powder, the Dutch Girl with a stick for cleaning powder, and the phonograph and dog for "Victrolas" and television sets, plaintiff's picture mark is one of the best and most universally recognized picture marks, known by the housewife and the trade and public generally including the automobile mechanic who uses petitioner's products for cleaning auto radiators.

The very fact that petitioner in its trade-mark registrations and advertising pictorial representations has kept up with current fashions and made slight and inevitable changes in style and dress, while retaining at all times the essential ensemble of elements and prominent characteristics of its picture trade-mark, is cogent evidence that petitioner has always intended to and has asserted that its trade-mark comprises that ensemble and those prominent characteristics. The ensemble and characteristics include the combination of the toilet bowl, a container in position over the bowl, material flowing from the can in a stream into the bowl, and a woman standing beside the toilet in a graceful poise and holding the can with one outstretched hand.

This is petitioner's exclusive trade-mark, recognized in the home and automobile repair and service shops, and by the trade and the public generally by its essential features and characteristics, which petitioner has always and consistently retained.

We submit that petitioner's trade-mark should not be restricted to every detail of the toilet, the can or the woman, and that protection should not be limited to "Chinese" copying, which seems to be the basis of the decision of the Court of Appeals.

Section 16 of the Trade Mark Act of 1905, as amended, (15 U. S. C. Sec. 96) is quoted in part in the footnote.* It is specifically noted that any person who shall "colorably imitate" a trade-mark is guilty of infringement.

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* "Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, . . . shall be liable to an action for damages therefor at the suit of the owner thereof; . . ."

"Difficulty frequently arises in determining the question of infringement; but it is clear that *exact similarity is not required,* as that requirement would always enable the wrong-doer to evade responsibility for his wrongful acts." (Emphasis supplied.) *McLean v. Fleming,* 96 U. S. 245, 255, (1877).

"Not only exact reproduction, but a 'colorable imitation' is within the statute; otherwise, the trade-mark would be of little avail as by shrewd simulation it could be appropriated with impunity." *Thaddeus Davids Co. v. Davids Mfg. Co.,* 233 U. S. 461, 469 (1914).

"The infringer rarely has the hardihood to make a Chinese copy." *Enoch Morgan's Sons Co. v. Ward,* 152 Fed. 690, 693, (C. C. A. 7, 1907).

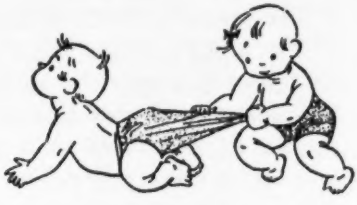
"A trade-mark is not to be resolved into its component parts and each part analyzed separately in cases of this sort." *Food Fair Stores v. Food Fair,* 177 F. 2d 177, 185. (C. C. A. 1, Sept. 21, 1949; *Woodbury,* C. J.)

At the top of the following page we reproduce the picture marks for rubber panties for babies involved in *International Latex Corporation vs. I. B. Kleinert Rubber Co.,* 104 F. 2d 382, 383, decided by the Court of Customs and Patent Appeals in June 1939. The Examiner of Interferences had found that the two marks, when placed side by side, were easily distinguishable but the Commissioner of Patents had reversed the Examiner. The Court affirmed the Commissioner stating that the baby's posture in the two marks "is substantially the same," that the side by side "comparison is not the test to be applied in considering the question of confusing similarity of the marks," that there was likelihood of confusion and that any reasonable "doubt must be resolved against the newcomer in the field."

TYPICAL INFRINGING OR CONFUSINGLY SIMILAR PICTURE TRADE-MARKS



Registered Picture



Confusingly Similar Picture

International v. Kleinert, 104 F. 2d 382





Plaintiff's picture infringed by Defendant's picture

Enoch Morgan's v. Ward, 152 F. 690





Registered Picture



Confusingly Similar Picture

Aunt Jemima v. Kirkland, 48 App. D. C. 248



Registered Picture



Confusingly Similar Picture

Aunt Jemima v. Blair, 50 App. D. C. 28

For convenience, we also have summarized pictorially above, the *Enoch Morgan's Sons* case, *supra,* and several additional cases out of many, which are exactly in point here. The illustrations and legends speak amply for them-

selves, and detailed discussion of them here is unnecessary.* We content ourselves by quoting from three of these cases.

> "Despite the differences in colors and direction in which the figures face, I have reached the conclusion that defendant's trade-mark adapted and used by it is in similitude of that of complainant; that confusion is likely to arise, and the goods of defendant be purchased in the belief that they are those of complainant." *Walter Baker & Co. v. Puritan Pure Food Co.*, 139 Fed. 680, 683 (S. D. N. Y. 1905).

> "In the pictorial marks there is no difference, except that appellee has substituted a young woman's face for a young man's." *Enoch Morgan's Sons case* (p. 693).

> "It would be difficult to imagine a more flagrant violation of the statute than the one here presented. The red core of the watermelon with its seed spots, held under the chin of the negro, is a good reproduction of the red bandana with its spots, tied around the neck of the negress. A mere glance at the marks is convincing. No evidence of confusion is necessary, nor can any amount of fine-spun discrimination withdraw the case from the direct operation of the statute." *Aunt Jemima Mills Co. v. Kirkland Distributing Co.*, 48 App. D. C. 248, 249, 250 (1919 C. D. 162).

It is clear that it is well established that the test of trade-mark infringement and unfair competition is likelihood of consumer confusion, resulting from memory and not from a side-by-side visual comparison. Chinese copying is not necessary to find infringement.

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* *Jansen Knitting Mills v. Herlich et al.*, 24 T. M. Rep. 48, D. C. E. D. Pa. 1934, referred to by the Court of Appeals (Rec. 291) and having to do with the famous Jansen "Diving Girl" registered for swimming suits, is directly in conflict with *Jansen Knitting Mills v. Spokane Knitting Mills, Inc.*, 44 F. 2d 656, D. C. E. D. Wash. N. D. 1930.

POINT II.

Defendant Is Guilty of Trade-Mark Infringement by Use, in Connection With the Sale of Its Product, of Pictorial Representations Which Have the Same Essential Ensemble and Prominent Characteristics as Petitioner's Picture Trade-Mark.

The District Court (Rec. 228) found that defendant's accused advertisements "have definite points of similarity with the trade-mark of plaintiff" and said:

> "Thus considered, the advertising material must be characterized as a colorable imitation of the plaintiff's trade-marks. Concededly there are variations, and this would necessarily be so if exact reproduction was to be avoided; . . ."

We submit that the fact findings of the District Court on the matter of infringement are correct as is clear from a mere inspection of our Chart showing petitioner's picture trade-mark, with petitioner's slight variations, and defendant's accused picture illustrations.

The Court of Appeals apparently failed to duly consider petitioner's picture trade-mark as a whole and the marked similarities between the characteristics of that mark and defendant's accused illustrations. On the contrary, the Court of Appeals, by a side-by-side comparison, dissected petitioner's mark into individual parts and gave undue consideration to minor details in the parts, and also to defendant's background, slogans and trade-mark "Vanish," appearing on the accused advertisements; all in conflict with decisions of this Court as well as of lower Federal Courts.

The Court of Appeals said (R. 291):

> "Clearly in advertising, to quote from the current musical play 'South Pacific,' 'There is nothing like the frame of a dame,' and we cannot see why the defendant is not as much entitled to take commercial advantage of pulchritude as the plaintiff."

Petitioner is not seeking a trade-mark monopoly on pulchritude but is seeking to protect its long exclusively used and famous picture trade-mark with its essential ensemble and its prominent characteristics. One portion of defendant's Exhibit C advertisement (p. 249) shows the head and shoulders of a young smiling girl and petitioner has made no complaint with respect to that pictorial representation. The Court of Appeals refers generally (R. 292-3) to other pictures used at times in some of petitioner's advertising, every piece of which, however, also shows petitioner's container with the registered mark on the label prominently displayed. Some of these other pictures, to which petitioner makes no exclusive claim, show women divorced from the essential ensemble of petitioner's registered trade-mark and in a very different pose or position from that shown in petitioner's mark. The Court of Appeals failed to note or say that these other sporadic pictures were not imitated or copied by defendant. That Court also disregarded in its opinion the fact that the District Court found (R. 231) that "The motive prompting the defendant to use the objected to advertisements was to increase its sales, and hence it could be inferred that it sought to divert some of plaintiff's trade profits thereby."; defendant having "knowledge that the plaintiff had used this symbol for many years." Defendant deliberately imitated petitioner's registered trade-mark, not, for example, the picture of the little girl, under the Caption "We don't talk about toilets!", to which the Court of Appeals specifically refers (R. 293).

Petitioner concedes that defendant may show in its advertising as many pictures of women in various poses, as it may desire, so long as the pictures do not "colorably imitate" petitioner's ensemble picture mark and defendant does not seek "to divert some of the plaintiff's trade profits thereby" (R. 231).

"* * * the field from which a person may select a trade-mark is practically unlimited, and hence there is no excuse for impinging upon or even closely approaching the mark of a business rival." *Kassman & Kessner, Inc. v. Rosenberg Co.*, 10 F. 2d 904, 905 (App. D. C. 1926).

"One entering a field of endeavor already occupied by another should, in the selection of a trade-name or trade-mark, keep far enough away to avoid all possible confusion." *Northam Warren Corp. v. Universal Cosmetic Co.*, 18 F. 2d 774, 775 (C. C. A. 7, 1927).

The Court of Appeals also says (R. 291):

"In the first place the plaintiff's marks are all on a plain background whereas the defendant's advertising usually showed a bathroom setting, including a bath tub, shower curtain, tiled walls, etc. In the second place the defendant in all its advertising prominently displayed its trade-mark 'Vanish' which is not at all similar to plaintiff's name 'Sani-Flush'."

The Court cites no authorities. However, it is well established that a registered trade-mark is infringed when it is colorably imitated, regardless of defendant's "background" or the use by the defendant of additional marks. It hardly could be contended seriously that defendant would have the right to use petitioner's word mark "Sani-Flush" in its advertising if defendant used entirely different backgrounds and illustrations.

"* * * It is insisted that because appellant adopted the two marks in connection with one article, appellee may lawfully use either alone. Appellant's marks were adopted and registered separately. They have been used separately in the advertisements. The word mark has always been employed for denoting the compound, the pictorial mark for stating a characteristic. We are of the opinion that appellant acquired and has maintained a separate property right in each mark, which was not dependent upon a conjoint use." *Enoch Morgan's Sons Co. v. Ward*, 152 Fed. 690, 693, *supra.*

"The Sapolio Case, *supra* [the *Enoch Morgan's Sons* case], is authority in this court to sustain the proposition that mere differences in the package or dress will not prevent infringement of a registered mark, if it is in fact colorably imitated." *Sierra Chemical Co. v. Berettini,* 33 F. 2d 397, 399, C. C. A. 7 (1929).

The Court of Appeals in its decision in the instant case (R. 291-2) next said:

"And in the third place the human female figures in the defendant's advertising are by no means strikingly similar to the ones used by the plaintiff in any of its marks. The plaintiff's earlier marks showed women dressed as housemaids, and its later ones showed a woman dressed conservatively as a matronly middle-aged housewife. The defendant, on the other hand, never used a housemaid in its advertising, but showed therein a very slim young housewife, perhaps a bride, ultra-fashionably dressed, i.e. in a very short skirt, wearing an elaborate apron, and standing in an exaggeratedly graceful bending posture pouring into a watercloset bowl with an expression of almost ecstatic delight upon her face. This contrasts sharply with the more conservative dress, staid posture, and expression of restrained joy on the faces of the women in all the plaintiff's trade marks, to say nothing of the rather buxom figure of the woman appearing in its later ones."

This side-by-side comparison, with its minutiae of detailed differences—unwittingly exaggerated we think—is in direct conflict with the proper test reiterated by this Court in *Beckwith v. Commissioner of Patents,* 252 U. S. 538, 545, 546, as follows:

"The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail."

The Court of Appeals for the First Circuit, speaking through Circuit Judge Woodbury, in *Pro-Phy-Lac-Tic Brush Co. v. Jordan Marsh Co.,* 165 F. 2d 549, 552 (1948),

stated that in determining likelihood of consumer confusion it is not enough "to make merely a side by side visual comparison" and then said:

> "Purchasers undoubtedly often compare a mark which they see when making a purchase with their memory of a mark which they have seen on some previous occasion. That is to say, they compare their memory of a mark which they have seen in the past with their visual impression of a mark which they presently see."

The Court of Appeals' statements are contrary to the fact findings of the District Court, because we respectfully submit, the Appellate Court applied an improper test and then spelled out differences, some of which are vague and nebulous, if not inaccurate. What is the distinction between a housemaid and a housewife? Each of defendant's accused representations shows a woman wearing an apron. We think this Court can take judicial notice of the fact that there are many slim and young and attractive housemaids. Do petitioner's later marks actually show a "matronly middle-age housewife" or a "buxom figure"? We doubt it. Why is a woman "ultra-fashionably dressed" simply because she wears a short skirt and an elaborate apron? Is petitioner's protection to be limited to long skirts and the plainest apron, even though petitioner's marks show different length skirts and aprons with some decorations? As to the Court's "expression of almost ecstatic delight," we think, with all due respect to that Court, that this is somewhat rhetoric. Certainly the expression on the face of the woman in defendant's accused advertisement, Exhibit C, shows no more delight than is portrayed on the faces of the woman in petitioner's marks. We think it is very clear that the postures are substantially the same in petitioner's marks and defendant's accused representations. Indeed the postures are almost identical, and we doubt if this Court can visually reconcile the Appellate Court's comment that the postures in defendant's adver-

tisements are "exaggeratedly graceful" and those in plaintiff's marks are "staid."

Obviously the Court of Appeals did not apply the test of infringement prescribed by its decisions and those of this Court in numerous decisions including *Beckwith v. Commissioner of Patents, supra*; that is to say, the Court of Appeals instead of considering the "commercial impression of" plaintiff's picture trade-mark "as a whole," erroneously considered the purchaser's impression as though it was derived "from its elements separated and considered in detail." The District Court on the other hand, after considering the trial testimony and reviewing the proofs and authorities in point applied the proper "purchaser's assumed memory" test and found as a matter of fact (R. 229):

> "* * * that the mode of advertising which the defendant has adopted would likely be misleading and result in consumer confusion, and, as such, was an infringement on the plaintiff's right to the exclusive use of the trade-mark."

We submit that in reversing the District Court's judgment the Court of Appeals committed such manifest error in fact and in law, as to warrant a review by this Court.

POINT III.

Defendant is Guilty of Unfair Competition.

The legal test of unfair competition is the same as that of trade-mark infringement, that is, the likelihood of consumer confusion as to the source of the goods.

Hanover Star Milling Co. v. Metcalf, 240 U. S. 403, 413 (1916);

Coca-Cola Co. v. Snow Crest Beverages, 162 F. 2d 280, 283, C. C. A. 1 (1947).

We submit that the District Court properly applied this test in finding defendant guilty of unfair competition,

and that the Court of Appeals erred in reversing the District Court.

The District Court found, in substance, the following: For thirty-five years petitioner had used continuously and exclusively its picture mark or symbol "to indicate the origin of" petitioner's goods. Millions of units of such goods had been sold at retail since adoption of the mark by petitioner. Hence the mark is "of great value" to petitioner and "is entitled to protection." The defendant "a relatively new competitor in the field" had successfully marketed its product for ten years by means of advertising of its own design before it adopted the accused pictures in its advertising (R. 230-1). "The defendant's newspaper advertisements and display cards do not in any way display the defendant's name, nor do the leaflets except in very small type on the back page * * *" (R. 220). "The motive prompting the defendant to use the objected to advertisements was to increase its sales [as admitted by defendant's president (R. 197-8)], and hence it could be inferred that it sought to divert some of the plaintiff's trade profits thereby." Defendant had "knowledge that the plaintiff had used this symbol for many years" and the adoption by defendant of a similar design "solely" as "a coincidence" was "difficult to believe," and under the "circumstances, intent may reasonably be inferred" (R. 231).

We invite this Court to examine again our Chart at the back of this brief as it so plainly confirms pictorially the findings of the District Court.

The Court of Appeals in its opinion does not refer to the above findings of the District Court, nor to the finding (R. 221) that petitioner "adopted and used a pictorial representation as a unique symbol or device to indicate the origin of the goods of its manufacture." The Court of Appeals for the most part merely says (R. 292) that "it does not appear that plaintiff has developed any unique

style or pattern of advertising peculiarly its own," apparently because plaintiff used additional pictures in some of its advertising. Obviously the Court of Appeals overlooked the fact that plaintiff's trade-mark or symbol, which the Court found to be a good and valid trade-mark, appears on every piece of petitioner's advertising and that some of petitioner's further pictures, such as the three appearing on our Chart, plainly have the same general "distinctive style, format and juxtaposition of elements"—quoting from the language of the Court of Appeals (R. 292). We trust that this Court compares these three pictures with defendant's three accused illustrations which likewise are reproduced on the Chart.

The Court of Appeals cites no case and we know of none which holds that a picture mark or symbol, employed for years by the owner on all of its own goods and in all of its own advertising, may be used by any competitor in the latter's advertising, merely because some of the owner's advertising includes additional illustrations, words or background.

Again the Court of Appeals failed to apply the proper test of unfair competition and its decision is in conflict with the decisions of this and lower Federal Courts. Furthermore, petitioner submits that the District Court's above decisive findings on the unfair competition issue are amply supported by substantial evidence and that the Court of Appeals disregarded and in effect set aside these findings contrary to Rule 52(a) of the Rules of Civil Procedure, and the cases decided by this Court and other Courts with respect to that Rule.

POINT IV.

The Findings of the District Court as to Defendant's Infringement and Unfair Competition Were Correct and Not Clearly Erroneous and Hence Under Rule 52(a) Should Not Have Been Disturbed by the Court of Appeals.

Rule 52(a) of the Federal Rules of Civil Procedure provides in part as follows:

> "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses."

At a full trial before the District Court, oral testimony was given by Mr. Raymond M. Schlabach, petitioner's treasurer and general manager, and a stipulation as to what other of petitioner's witnesses would testify to was read in open Court and forms part of the Record here (R. 55 to 126, 130 to 146, 203). The court also heard the oral testimony of two witnesses for defendant, including that of Mr. Dunaway, defendant's president (R. 148 to 203). Many exhibits were offered in evidence.

As we already have shown, the District Court made careful, full and explicit findings of fact. Among its ultimate findings were that defendant's accused "advertising material must be characterized as a colorable imitation of the plaintiff's trade-marks," that from the facts of record and the admissions of defendant "it could be inferred" that defendant had deliberately "sought to divert some of the plaintiff's trade profits" and that defendant's accused advertisement "would likely be misleading and result in consumer confusion" (R. 228 to 231).

The findings of the District Court are supported by substantial evidence, and hence are not "clearly erroneous." The Court of Appeals practically disregarded them. Instead of giving due effect to these factual deter-

minations of the Trial Court, the Court of Appeals, in effect, set them aside by indirection and silence, and substituted its own judgment of the facts or the application of legal doctrines only to facts contrary to those found by the Trial Court, in violation of Rule 52(a) and contrary to decisions of this Court and of Appellate Federal Courts, including the Court of Appeals for the First Circuit. We quote here from several of such decisions, which are clearly in point.

This Court in *Walling v. General Industries Co.*, 330 U. S. 545 (1947), after reviewing the findings and inferences drawn by the District Court, said at page 550:

> "At the least, we think that in drawing such inferences the Court was not clearly wrong, and conclude that the findings should therefore have been left undisturbed."

and in the footnote cited Rule 52(a) and *Lawson v. United States Mining Co.*, 207 U. S. 1, 12; *Butte & Superior Copper Co. v. Clark-Montana Realty Co.*, 249 U. S. 12, 30; *District of Columbia v. Pace*, 320 U. S. 698, 701; *Adamson v. Gilliland*, 242 U. S. 350; *United States v. United Shoe Machinery Co.*, 247 U. S. 32, 37, 38, 41.

The Court of Appeals for the First Circuit, speaking through Judge Woodbury in each instance, expressly said:

> "This question of *infringement* [of a patent] is also one of *fact* (citing cases). As such the conclusion of the master and the court below [on that question] is not to be disturbed by us *unless clearly erroneous.*" (Emphasis supplied.) *B. F. Sturtevant Co. v. Massachusetts Hair and Felt Co.*, 122 F. 2d 900, 914, (1941);

and,

> "Thus the ultimate question of infringement [of a trade mark] is one of the type ordinarily classified as one of fact (citing cases), and as such it is one primarily for the fact-finding tribunal—in this case the district

court—reviewable here only for clear error under Rule 52(a)." *Dwinnell-Wright Co. v. National Fruit Products Co.*, 140 F. 2d 618, 623 (1944);

and also,

"And we have held in this Circuit that this ultimate question of the likelihood of consumer confusion as to source is one of fact." *Coca-Cola v. Snow Crest Beverages*, 162 F. 2d 280, 283, *supra*.

Manifestly, the District Court was bound by the rule stated and reiterated in the above decisions of the Court of Appeals for the First Circuit as well as in decisions of this Court. The District Court followed that rule and made detailed findings of fact and the ultimate findings of fact that there was *likelihood of consumer confusion as to source*. Clearly, the Court of Appeals in reversing the judgment of the Trial Court did so in conflict, not only with the decisions of this Court, but with its own decisions which the Trial Court so carefully followed.

CONCLUSION.

Each of the questions presented is of prime importance to the protection of the purchasing public generally, as well as to trade-mark and trade-name owners. We have shown, we believe, that the Court of Appeals in answering each of those questions in the negative runs counter to the decisions of this Court, its own decisions and the decisions of other Federal Appellate Courts and District Courts. Thus there is a serious conflict of decisions in the present instance.

The general principles which are clearly applicable here are so ably and aptly expressed in the language of Mr. Justice Frankfurter in *Mishawaka Mfg. Co. v. Kresge Co.*, 316 U. S. 203, 205 (1942), that we quote some of the language in part here:

"The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is

true that we live by symbols, it is no less true that we purchase goods by them. A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress. And in this case we are called upon to ascertain the extent of the redress afforded for infringement of a mark registered under the Trade-Mark Act of 1905.

"The 'right to be protected against an unwarranted use of the registered mark has been made a statutory right' by that Act. *Thaddeus Davids Co. v. Davids Mfg. Co.*, 233 U. S. 461, 471."

For the reasons stated in this brief and petition, petitioner respectfully requests that a writ of certiorari be issued to review the judgment of the Court of Appeals for the First Circuit, in this action.

Respectfully submitted,

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IN THE

Supreme Court of the United States

OCTOBER TERM 1949

No. 672

THE HYGIENIC PRODUCTS COMPANY,
Petitioner,

vs.

JUDSON DUNAWAY CORPORATION,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

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Opinions Below

The opinion of the District Court was reported in 81 Fed. Supp. 935 and may be found at pages 216 to 234 of the Record. The opinion of the Court of Appeals for the First Circuit was reported in 178 Fed. (2d) 461 and may be found at pages 285 to 293 of the record.

Jurisdiction

The jurisdiction of this Court to issue the writ of certiorari applied for is predicated upon United States Code Title 28 Section 1254.

Statement of Case

Believing that petitioner's statement of the facts is insufficient to afford a complete understanding of the questions presented by the petition, respondent submits the following statement of all the facts which respondent believes to be material to the petition.

Petitioner has been engaged, since 1911, in the manufacture and sale throughout the United States of a toilet bowl cleaner containing bisulphate of soda, sodium chloride and powdered soapstone. This product was covered by two patents which petitioner obtained in 1912 and 1915 respectively (Exhs. H-1, R. 74, 257-9 and H-2, R. 75, 260-3). The second of these patents did not expire until 1932 and it was only after that date that anyone could bring out a similar competitive product without risk of patent infringement.

Petitioner adopted the term SANI-FLUSH as the trademark for its product about 1911 and has since used that designation. Its product is sold in cans which are predominantly yellow having three yellow panels bordered with blue and white lines. On the larger panel the trademark SANI-FLUSH is prominently displayed in red letters and this panel also carries the pictorial representation of a toilet bowl and a female figure standing beside the toilet bowl and holding in her hand a can of SANI-FLUSH from which material is falling into the toilet bowl.

Petitioner has asserted trade-mark rights in the pictorial representation in addition to its trade-mark rights in the designation SANI-FLUSH. It bases its cause of action solely upon its use of this pictorial representation.

From time to time petitioner has changed the style of this pictorial representation which it claims as its trademark and has secured a number of certificates of registration therefor from the United States Patent Office (Exhs. A-1 to A-7, R. 56, 57, 237-243). None of the pictorial representations shown in registrations Exhibits A-1 to A-5 (R. 56-7, 237-241) have been used by petitioner on its product since about 1938 (R. 123).

In its advertising petitioner has used display cards Exhibits I-1 and I-2 (R. 82), leaflets (Exhs. B-1 and B-2, R. 81, 244-247), and periodical advertisements (see respondent's Request for Admissions) which portray a female figure standing beside a toilet bowl holding a can in her hand from which material is falling into the toilet bowl. In this advertising material petitioner's trade-mark SANI-FLUSH is prominently displayed, and in a great deal of it the SANI-FLUSH can is reproduced.

In 1937 respondent developed and commenced the distribution of a product designed for two purposes, namely, as a toilet bowl cleaner and bathroom deodorant (R. 167). This product is poured into a toilet bowl where, in contact with water, it cleans and deodorizes by chemical action. It was first sold in an oval black and white can on which respondent's trade-mark VANISH prominently appeared in white letters together with the representation of a toilet bowl and a stream of material falling from the word VANISH into the toilet bowl (Exh. 4, R. 133).

In 1942 the style of can was changed to a taller cylindrical shape printed in blue and white but still displaying prominently the trade-mark VANISH and the representation of a toilet bowl and the stream of material falling from the word VANISH into the toilet bowl, as above described. This can, which has been used ever since, is exemplified by Exhibit L (R. 94).

Beginning in 1937 respondent advertised its product by means of leaflets, folders, display cards, window streamers, and the like, which show a can of VANISH suspended above a toilet bowl with material falling from the can into the toilet bowl (Exh. 10, R. 175, 270, 271, and Exh. 11, R. 175), and one of which (Exh. 9, R. 173) shows, against a bathroom background, a woman holding a can of VANISH from which material is falling toward a toilet bowl which is not shown in full but clearly indicated by a raised seat cover. No complaint was ever made with respect to any of this advertising (R. 137) and it is not now complained of (R. 169) even though petitioner was fully informed of respondent's activities in this connection (R. 132).

In June 1946 respondent commenced to use a display card (Exh. K, 93, 170) which shows a bathroom background including tiled walls, lavatory, shower, shower curtains, and toilet bowl, and a woman holding a can of VANISH over the toilet bowl with material falling from the can into the toilet bowl.

In December 1946 respondent commenced distribution of leaflets advertising the product VANISH (Exh. C, R. 58, 248, 249), and bearing a picture of a bathroom with tiled walls, bath tub, shower curtains and toilet bowl, and a woman holding a can of VANISH over the toilet bowl with material falling from the can into the toilet bowl.

During March and April 1947 respondent caused to be published in a number of newspapers an advertisement of its product VANISH (Exh. E, R. 58, 253) illustrated with the pictorial representation of a woman holding a can of VANISH over a toilet bowl with material falling from the can into the toilet bowl. At about the same time it caused another advertisement (Exh. E-1, R. 61, 253) of its product VANISH to be published in newspapers, the advertisement being illustrated with the representation of a toilet bowl, a can of VANISH suspended over the toilet bowl with material falling from the can into the toilet bowl and a hand holding the can. In all the advertising material complained of the can clearly labelled VANISH is prominently depicted and in the colored material the characteristic blue and white color scheme of the VANISH can is reproduced.

The composition of this advertising material followed generally accepted and widely used principles of display advertising. The record establishes that this form of advertisement showing the product, the human form or a part thereof, and how to use the product or showing the product in use (R. 156) was widely employed in advertisements. Also that advertisements with persons in them are particularly effective in attracting attention; that advertisements with women in them attract more attention from women; that advertisements showing the product are particularly effective and desirable where so much

buying is done in self-service stores; and that advertisements showing a product in use are highly desirable (R. 162). It was also established on the basis of a survey of four magazines containing 1255 advertisements, that 96% were illustrated; that 88% showed the product or a package of it, in the illustration; that 75% showed the product or a package of it and a human figure or part thereof; and that 44% showed the product or a package of it and a human figure or part thereof in the act of using or showing how to use the product (R. 156).

There was no evidence that anyone had in fact been deceived by respondent's advertising or led to purchase respondent's product in the belief that petitioner's product was being supplied (R. 220).

On these facts the District Court held that respondent had infringed petitioner's trade-mark rights in the pictorial representation and had competed unfairly with petitioner. The Court of Appeals reversed and directed the entry of judgment for respondent.

Argument

In opposing the grant of the petition respondent makes the following points:

1. The Court of Appeals correctly concluded that petitioner's alleged trade-mark rights do not constitute a proper basis for the broad monopoly claimed by petitioner of a commonly used type of advertising as applied to its own and to competitive products.

2. The Court of Appeals correctly applied the rule that the likelihood of consumer confusion is the proper test of infringement and unfair competition, and it was entirely proper for the Court of Appeals to do so because the contrary findings of the trial court were based entirely upon documentary evidence and physical exhibits which the Court of Appeals was as competent to consider as the trial court.

3. The questions presented by the petition are not such as to warrant consideration by this Court or the grant of the writ.

---

(1) The essential facts in this case can be very concisely summarized. Each party manufactures a chemical powder which is dispensed in small cans and sold at retail to housewives, among others, for cleansing watercloset bowls. Petitioner calls its product SANI-FLUSH which it registered as its trade-mark and which appears prominently on its cans. Respondent calls its product VANISH which it registered as its trade-mark and which appears prominently on its cans. The cans of the respective parties differ in shape, size, color and labelling, the labels of petitioner's cans being predominantly yellow and those of respondent's predominantly blue, so that, as petitioner concedes, the dress of respondent's product is entirely dissimilar to that of petitioner's.

The only controversy in this case is about the use of a picture representing a housewife or maid holding a can of the powdered material and shown in the act of pouring the material from the can into a watercloset bowl. This picture petitioner places on its cans and uses in some of its advertising, thus showing its product in use and graphically describing the purpose for which and the manner in which its product is used. Respondent, in its advertising, but not on its cans, uses a similar picture to describe the purpose for which and the manner in which its product is used.

Despite the fact that petitioner's pictorial representation is clearly descriptive, petitioner asserts, but does not prove by competent evidence, that the primary purpose or function thereof is to indicate the source of its product and therefore that the picture constitutes a valid trade-mark and, for this reason, petitioner maintains that respondent should be perpetually enjoined from using a similar picture showing respondent's product in use and illustrating its utility and manner of application. Thus, the fundamental question at issue in this case is whether, by adopting and using, in connection with the sale of its product, a picture

descriptive of its utility and manner of application, petitioner thereby acquired a perpetual monopoly of the use of that or any similar picture in advertising such products, on the theory that the picture constitutes a valid trade-mark and therefore may be exclusively appropriated by petitioner alone.

In approaching the answer to this question, the Court of Appeals stated two propositions upon which it based its decision. The first proposition, which quotes from a decision of this Court (*Canal Co.* v. *Clark*, U. S. Sup. Ct. 1872, 80 U. S. 311, 324) is that

> "a mere representation of a can with powdered material flowing from it into a watercloset bowl could not constitute a valid trade-mark for the product here involved for one 'has no right to appropriate a sign or a symbol, which, from the nature of the fact that it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose' " (R. 289).

The second proposition stated by the Court of Appeals is that

> "A mere glance at the advertising section of almost any newspaper or periodical renders it unthinkable that any single manufacturer of such products as, for instance, women's underclothing, bathing suits or stockings, to mention only a few outstanding examples, can possibly be entitled to appropriate unto itself alone the exclusive right to advertise its products by representing them in use" (R. 291).

Based on these two propositions, the Court of Appeals refused to hold that whatever trade-mark rights petitioner had secured in its said picture were broad enough in scope to include respondent's picture, that is to say, broad enough to give petitioner a perpetual monopoly of using in advertising a similar picture which could easily be distinguished from its own picture. It matters little that the court reached its decision by holding that petitioner's picture

constituted a valid trade-mark of limited scope, as it did, rather than holding that the descriptiveness of the picture precluded petitioner from acquiring any valid trade-mark in it at all.

(2) The Court of Appeals correctly applied the rule that likelihood of consumer confusion is the proper test of infringement and unfair competition.

> "The only obligation resting upon Kellogg Company was to identify its own product lest it be mistaken for that of the plaintiff." (*Kellogg Company* v. *National Biscuit Company*, U. S. Sup. Ct. 1938, 305 U. S. 111, 119.)

> "A trade-mark only gives the right to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his. • • • When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth." (*Prestonettes* v. *Coty*, U. S. Sup. Ct. 1924, 264 U. S. 359, 368.)

> "• • • the legal test of trade-mark infringement is the same as the legal test of unfair competition, and basically that test is the likelihood of consumer confusion as to the source of the goods" (*Coca Cola Co.* v. *Snow Crest Beverages*, 1st C. C. A. 1947, 162 Fed. (2d) 280, 283. Certiorari denied 332 U. S. 809.)

Since the only evidence in the present case bearing on the issue of likelihood of consumer confusion, consists of documents and physical exhibits, it was entirely proper for the Court of Appeals to review this evidence.

> "A finding is 'clearly erroneous' when although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed." (*United States* v. *United States Gypsum Company*, U. S. Sup. Ct. 1948, 333 U. S. 364, 395.)

> "A finding of fact is clearly erroneous if it is against the clear weight of the evidence. It does not suffice

that it be supported by evidence. * * * In determining whether the finding was correct, we shall examine documentary evidence which we are as competent to consider as the trial court, * * *" (*Fleming* v. *Palmer*, 1st C. C. A. 1941, 123 Fed. (2d) 749, 751.)

"An incorrect conclusion by a trial court qualifies as a 'clearly erroneous' finding, for the correction whereof on appeal Rule 52 (a) specifically provides." (*Kuhn* v. *Princess Lida*, 3rd C. C. A. 1941, 119 Fed. (2d) 704, 706.)

If the Court of Appeals found the conclusion which the District Court drew from the documents and physical exhibits to be clearly erroneous, it was entirely proper for that court to set it aside and find that there was no likelihood of consumer confusion, which it did, as follows:

"Viewed as an entirety, for the commercial impression of an advertisement no less than a trade-mark is derived from it as a whole, not from its separate elements considered apart and in detail, it seems to us clear that these distinctive features of the defendant's advertising, in spite of its use therein of the feature it is entitled to employ, that is to say, an alluring young woman using its product, prevent the possibility of there being any genuine likelihood that purchasers of 'Vanish' would be so confused by the advertising of that product that they would think they were purchasing 'Sani-Flush' (R. 292).

* * * * *

"In conclusion it will suffice to say that defendant's advertising viewed as a whole by no means so closely resembles either the plaintiff's mark or its advertising, viewed also as a whole, as to warrant the conclusion that anyone seeing it would be likely to confuse the defendant's product with that of the plaintiff" (R. 293).

(3) The questions raised by the petition may be restated thus:

1. Are petitioner's alleged trade-mark rights to be strictly construed?

2. Has respondent infringed?

3. Has respondent competed unfairly?

4. Did the Court of Appeals give due regard to Rule 52 (a)?

None of these questions are such as to call for the granting of the petition under the criteria set forth in paragraph 3 (b) of Rule 38 of the rules of this Court. It does not appear, that there is any conflict of decisions in the same matter, or that an important unsettled question of Federal law is involved, or that any Federal question has been decided in conflict with applicable decisions of this Court. And certainly the reversal of the District Court by the Court of Appeals does not constitute such a departure from the usual course of judicial proceedings prescribed by Rule 52 (a) as to warrant the grant of the petition.

Essentially the questions presented by the petition relate solely to this particular case and can have no possible application to any other case.

A review of trade-mark and unfair competition cases in the Circuit Courts of Appeal which have been reported during the past five years, reveals that out of 43 petitions for certiorari which were filed in this Court, 40 were denied. Since this Court does not ordinarily grant certiorari merely to review findings in particular cases in order to determine whether they are correct and were properly made, the writ should not issue.

Respectfully submitted,

MANVEL WHITTEMORE
CHARLES F. MILLER, JR.
Solicitors for Respondent

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JOHN P. CARLETON
Counsel.

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In the Supreme Court of the United States

OCTOBER TERM 1949.

No. 672.

THE HYGIENIC PRODUCTS COMPANY,
Petitioner,

vs.

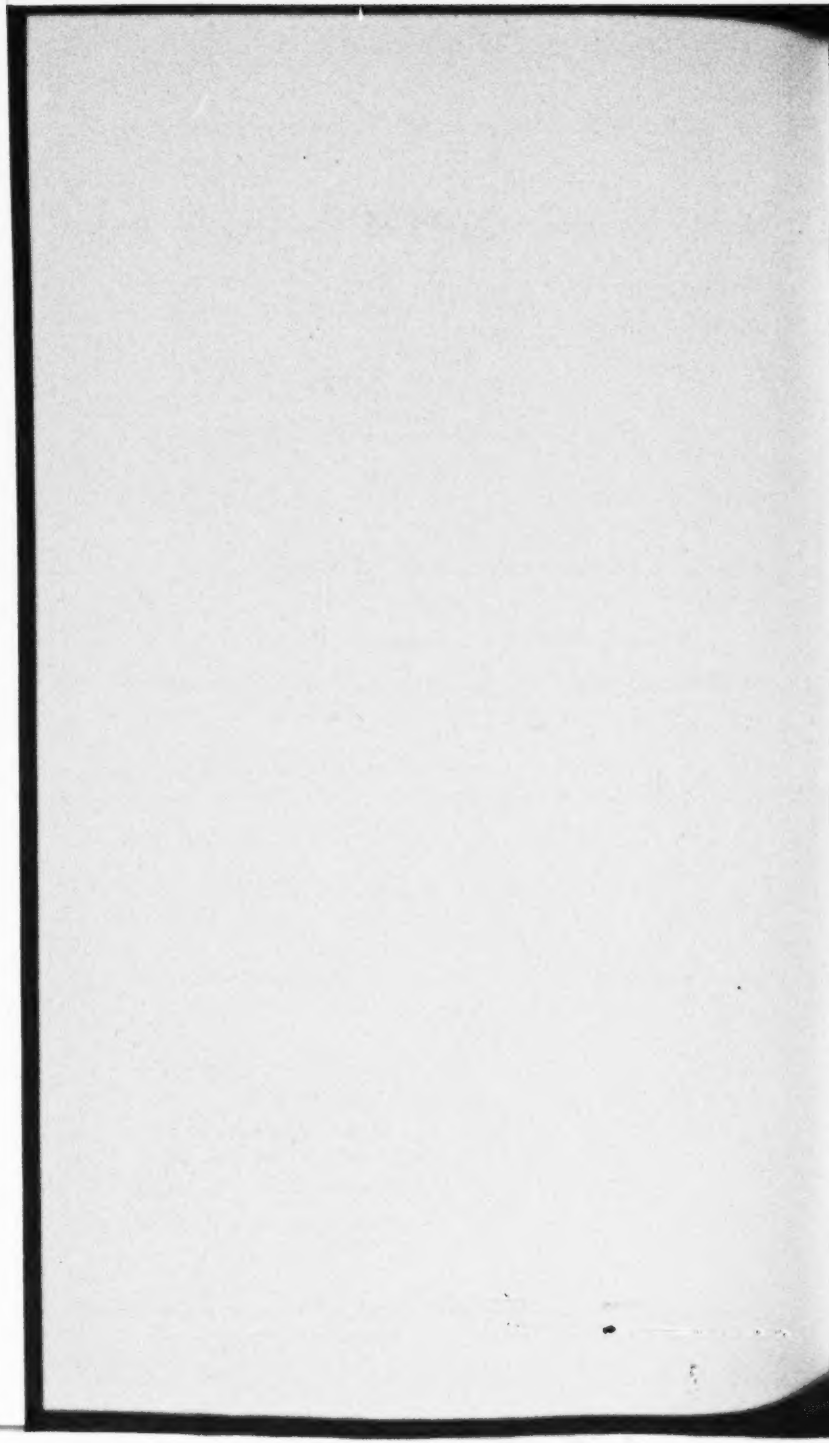
JUDSON DUNAWAY CORPORATION,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT.

PETITIONER'S REPLY BRIEF.

HARRY W. LINDSEY, JR.,
HARRY FREASE,
JOSEPH FREASE,
FRANK J. SULLOWAY,
RANDOLPH C. RICHARDSON,
Counsel for Petitioner.

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JUDSON DUNAWAY CORPORATION,
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ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT.

PETITIONER'S REPLY BRIEF.

RE RESPONDENT'S "STATEMENT OF CASE."

For the most part, respondent's "Statement of Case" merely reiterates, though more briefly, the facts which we stated in the petition and supporting brief.

Respondent does refer (Brief pp. 4, 5) to respondent's advertising and to the testimony of its witness, Professor Borden, with respect to figures on advertisements appearing in four magazines—testimony which is not discussed in the petition or supporting brief, as we did not think it pertinent. It is significant that respondent refrains from advising this Court that Professor Borden's figures are confined solely to the *October, 1947* issues of the four magazines (R. 155). This was *thirty six years after* petitioner adopted its picture trade-mark, and also was after this action was filed. The record does not show anything as to the accepted general advertising practice in 1911, nor in 1937 when respondent entered the field. The record shows nothing (other than recognization of and respect for peti-

tioner's rights, R. 110, 112), as to the advertising practices of petitioner's and respondent's competitors engaged in manufacturing and selling cleaning materials for auto radiators and toilet bowls. The record does not show whether any of the advertising pictures referred to by Professor Borden had been long exclusively used by the producer of the product. Nor does it show whether any of the pictures had been registered as a trade-mark. Professor Borden's figures come to naught.

We do, however, appropriately quote here a significant sentence from Professor Borden's testimony (R. 164):

> "It is my observation that not more than half give the name of the companies; *whenever a trade-mark is well known, highly individualized mark,* it is very common to leave the name of the company off, and many of the products, from surveys, *we know that consumers do not know the name of the companies that make these trade-mark articles.*" (Emphasis ours);

and also quote from related findings of the District Court:

> "The defendant's newspaper advertisements and display cards do not in any way display the defendant's name * * *" (R. 220);

and

> "The motive prompting the defendant to use the objected to advertisements was to increase its sales * * *" (R. 231) [as admitted by its president (R. 197-8)].

Furthermore, the fact that petitioner commonly uses its registered picture trade-mark and similar pictures in advertising its own product does not destroy the scope of protection to be afforded petitioner's valid picture trade-mark rights based on continuous and exclusive use of the trade-mark since 1911. The use of a picture trade-mark in advertising is a common and proper merchandising practice "to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears." *Mishawaka Mfg. Co. v. Kresge Co.*, 316 U. S. 203, 205 (1942).

RE RESPONDENT'S "ARGUMENT."

Respondent's brief does not in any way attempt to answer the propositions and authorities presented and discussed in petitioner's supporting brief. Indeed, there is no reference to the supporting brief nor to any of petitioner's authorities, except one.

On page 6 of its brief respondent says that "petitioner's pictorial representation is clearly descriptive," which of course is directly contrary to the findings of not only the District Court (R. 234) but also of the Court of Appeals (R. 290). Respondent ignores these findings and our authorities supporting them. It does not directly challenge our position that the trade-mark, in its essential ensemble with prominent characteristics, must be considered as a whole.

On page 7 of respondent's brief, respondent quotes from the Court of Appeals' decision that "a mere representation of a can with powdered material flowing from it into a water closet bowl could not constitute a valid trademark * * *" (R. 289). The Court of Appeals also said, however, that "this does not establish that the plaintiff's marks are invalid * * *" (R. 289). We have no quarrel with these statements. Respondent had used such mentioned "representation" of material flowing from a can into a toilet bowl for 10 years without any complaint from petitioner (R. 290).

The respondent quotes from the Court of Appeals' so-called "second proposition" with respect to what "A mere glance at the advertising section" of a newspaper or periodical shows, but failed to quote the next succeeding sentence which reads:

> "Of course, the defendant cannot represent its product in use in such a setting, or in such a way, as to render it likely that the purchasing public will confuse its product with that of the plaintiff." (R. 291.)

On page 8 of its brief respondent states that the "likelihood of consumer confusion is the proper test of infringe-

ment''—a test that we also asserted in petitioner's main brief (p. 18). Respondent disregards the rule that it is not enough ''to make merely a side by side visual comparison'' and that the purchaser's ''memory'' test should be applied [*Pro-Phy-Lac-Tic Brush Co. v. Jordan Marsh Co.*, 165 F. 2d 549, 552 (C. C. A. 1)]. Instead, respondent merely quotes from *Kellogg Company v. National Biscuit Company*, 305 U. S. 111; *Prestonettes v. Coty*, 264 U. S. 359, and *Coca Cola Co. v. Snow Crest Beverages*, 162 F. 2nd 280 (C. C. A. 1), all of which are clearly distinguishable from the facts of the instant case. In the *Kellogg* case the plaintiff had not used for many years the words ''Shredded Wheat'' as a trade-mark and the words became dedicated to the public upon expiration of the plaintiff's patents. In the *Coty* case the defendant purchased from ''Coty'' the genuine powder which defendant used. In the *Coca-Cola* case defendant's mark ''Polar Cola'' was held to be dissimilar from plaintiff's registered trade-mark ''Coca Cola,'' whereas in the instant case respondent admits that its picture representation is ''similar'' to petitioner's registered mark (R. Brief 6).

Respondent also argues, in effect, that because the labels on its cans are different and some of the background of its accused pictures is different from petitioner's can and picture trade-mark, there can be no confusion and hence no infringement. Respondent does not, because it could not, answer our authorities appearing on pages 21 and 22 of petitioner's supporting brief that ''mere differences in the package or dress will not prevent infringement of a *registered* mark, if it is in fact colorably imitated''—quoting from *Sierra Chemical Co. v. Berettini*, 33 F. 2d 397, 399, (C. C. A. 7, 1929). (Emphasis ours.)

Finally respondent advances (p. 10) the untenable argument that because this Court, during the past five years has denied 40 petitions out of 43, the writ should not issue in the instant case. Its counsel obviously think more highly than they pretend of the questions presented by and reasons relied upon for the grant of a writ.

We submit that we have demonstrated in our brief in support of the petition that petitioner's questions have not been specifically passed upon by this Court, and that they are important and unsettled questions relating to the entire field of picture trade-marks; and further that the decision of the Court of Appeals is in conflict with decisions of this and other Courts including, among others, *McLean v. Fleming*, 96 U. S. 245; *Thaddeus Davids Co. v. Davids Mfg. Co.*, 233 U. S. 461; *Beckwith v. Commissioner of Patents*, 252 U. S. 538; and *Walling v. General Industries Co.*, 330 U. S. 545. Furthermore, respondent's contentions come somewhat with poor grace, as respondent has filed its cross-petition, No. 681, asserting, in effect, that there are present unsettled questions of Federal Law having general application to the field of picture trade-marks and of great importance to trade-mark owners and the general public.

We again respectfully urge that a writ of certiorari issue to review the judgment of the Court of Appeals for the First Circuit, in this action.

Respectfully submitted,

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JOSEPH FREASE,
FRANK J. SULLOWAY,
RANDOLPH C. RICHARDSON,
Counsel for Petitioner.

Washington, D. C.
April 15, 1950.

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IN THE

Supreme Court of the United States

OCTOBER TERM 1949

No. 681

JUDSON DUNAWAY CORPORATION,
Petitioner,

vs.

THE HYGIENIC PRODUCTS COMPANY,
Respondent.

CROSS-PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT.

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IN THE

Supreme Court of the United States

OCTOBER TERM 1949

JUDSON DUNAWAY CORPORATION,
Petitioner,
vs.
THE HYGIENIC PRODUCTS COMPANY,
Respondent.

No. _____

CROSS-PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT *PRAYED FOR ONLY IN THE EVENT THAT CERTIORARI IS GRANTED IN NO.* 672

TO THE HONORABLE, THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, Judson Dunaway Corporation, respectfully prays that, in the event that the petition for writ of certiorari by The Hygienic Products Company, No. 672, to review the judgment of the Court of Appeals for the First Circuit in the case brought by The Hygienic Products Company against petitioner is granted, another writ of certiorari be granted to review the holding by said court that respondent's registered trade-marks are valid and its consequent refusal to hold that respondent's trade-mark registrations should be cancelled pursuant to the Trade-mark Act of 1946, and in that behalf petitioner respectfully represents:

Respondent commenced this action in the District Court for the District of New Hampshire on May 31, 1947, charging unfair competition and infringement of six registered

trade-marks. The trade-marks involved are picture marks and the charged infringement and unfair competition was based upon respondent's use, in its advertising, of pictures alleged to be similar. The District Court held for respondent, concluding that its registered trade-marks were valid, that they had been infringed, and that petitioner had competed unfairly with respondent. An injunction was granted. Petitioner thereupon appealed to the Court of Appeals for the First Circuit which, although holding that respondent's pictures constituted valid trade-marks and were properly registered as such, found no trade-mark infringement or unfair competition, vacated the judgment of the District Court, and remanded the case for the entry of judgment for petitioner. The judgment of the Court of Appeals was entered on December 15, 1949.

Respondent The Hygienic Products Company is petitioning this Court for a writ of certiorari and petitioner Judson Dunaway Corporation files this *cross-petition* to bring before this Court the issue of trade-mark validity and the applicability of the Trade-mark Act of 1946, in the event that respondent's petition should be granted.

Summary and Short Statement of the Matter Involved

The facts, in so far as they are material to this petition, may be briefly stated as follows:

Respondent (plaintiff below) has been engaged since 1911 in the manufacture and sale throughout the United States of a toilet bowl cleaner containing bisulphate of soda, sodium chloride and powdered soapstone. As used, this product is poured into a toilet bowl where, in contact with water, it cleans by chemical action. It was covered by two patents which respondent obtained in 1912 and 1915 respectively (Exhs. H-1, R. 74, 257-9 and H-2, R. 75, 260-3).

Respondent adopted the term SANI-FLUSH as the trade-mark for its product about 1911 and has since used that

designation. Respondent's product is sold in cans which bear the pictorial representation of a toilet bowl and a female figure standing beside the toilet bowl and holding in her hand a can of SANI-FLUSH from which material is falling into the toilet bowl.

Respondent has asserted trade-mark rights in the pictorial representation in addition to its trade-mark rights in the designation SANI-FLUSH. The present cause of action is based upon its claim of a perpetual exclusive right to use this pictorial representation of its product and of its utility, on the theory that it is a valid trade-mark.

From time to time respondent has changed the style of this pictorial representation and has secured a number of certificates of registration therefor from the United States Patent Office (Exhs. A-1 to A-7, R. 56, 57, 237-243). None of the pictorial representations shown in registrations Exhibits A-1 to A-5 (R. 56-7, 237-241) have been used by plaintiff on its product since about 1938 (R. 123).

There are seven registrations as follows:

Certificate 108,251, dated in 1916, shows an old-fashioned housemaid pouring from a can into a toilet bowl (Exh. A-1, R. 56, 237).

Certificates 263,929, dated in 1929, and 298,650, dated in 1932, are alike except for the words SANI-FLUSH appearing in the former. They both show a more up to date housemaid pouring from a can into a toilet bowl (Exhs. A-2 and A-3, R. 56, 238, 239).

Certificates 372,096 and 372,097, both dated in 1939, are alike except for the inclusion of the words SANI-FLUSH in the latter. Both show a young housewife wearing an apron and in the act of pouring from a can into a toilet bowl (Exhs. A-4 and A-5, R. 57, 240, 241).

Certificates 374,844 and 374,845, both dated in 1940, are alike except that the name SANI-FLUSH appears in the latter. They both show a photographic portrait of a certain rather matronly appearing woman named Ruby Sleeth in the act of pouring from a can into a toilet bowl (Exhs. A-6 and A-7, R. 57, 242, 243).

In 1937 petitioner (defendant below) commenced the distribution under its own registered trade-mark VANISH of a product of the type disclosed in respondent's expired patents to be used as a toilet bowl cleaner and bathroom deodorant (R. 167).

In advertising its product petitioner used a display card (Exh. K, R. 93, 170) which shows a bathroom background including tiled walls, lavatory, shower, shower curtains, and toilet bowl, and a woman holding a can of VANISH over the toilet bowl with material falling from the can into the toilet bowl. It also used consumer leaflets (Exh. C, R. 58, 248, 249) bearing a picture of a bathroom with tiled walls, bath tub, shower curtains and toilet bowl, and a woman holding a can of VANISH over the toilet bowl with material falling from the can into the toilet bowl.

Petitioner caused to be published in a number of newspapers an advertisement of its product VANISH (Exh. E, R. 58, 253) illustrated with the pictorial representation of a woman holding a can of VANISH over a toilet bowl with material falling from the can into the toilet bowl and another newspaper advertisement (Exh. E-1, R. 61, 253) illustrated with the representation of a toilet bowl, a can of VANISH suspended over the toilet bowl with material falling from the can into the toilet bowl and merely a hand holding the can.

The charges of trade-mark infringement and unfair competition were based solely upon petitioner's use of the aforesaid advertising material.

In the District Court and in the Court of Appeals petitioner made the following points:

1. That respondent's pictorial representations of its product and of the manner of its use do not constitute good trade-marks at common law or under the Federal statutes because they are descriptive.

2. That all of respondent's trade-mark registrations are invalid because the marks registered thereby are de-

scriptive and because the marks registered by Nos. 108,251, 263,929, 298,650, 372,096 and 372,097 have been abandoned.

3. That the Trade-mark Act of 1946 applies and the District Court had jurisdiction to direct, and should have directed, cancellation of respondent's trade-mark registrations.

4. That even if any one of respondent's trade-mark registrations possesses some measure of validity, the petitioner has not infringed.

5. That petitioner in its advertising complained of merely employed a widely used type of illustration to show the public what its product is and how its product is to be used without intending or accomplishing any trade-mark infringement or unfair competition with respondent.

6. That by reason of the outstanding differences in appearance between respondent's package and petitioner's package and by reason of petitioner's prominent use of its commercial signature, namely, its own trade-mark VANISH, there is no likelihood of deception or confusion and no unfair competition with respondent.

7. That the complaint should be dismissed, the relief demanded by the counterclaim should be granted, and petitioner should be awarded the costs of this action in the District Court and in the Court of Appeals.

The Court of Appeals held for petitioner on Points 4, 5, 6 and 7 except that it refused the relief demanded by the counterclaim, and held for respondent on Points 1 and 2 except that it did not pass on the issue of abandonment, and declined to rule on Point 3.

Jurisdiction

The jurisdiction of this Court to issue the writ of certiorari applied for is predicated upon United States Code

Title 28 Section 1254. The Court of Appeals had jurisdiction under Title 28 Section 1291, and the District Court under Title 28 Sections 1332 and 1338 because this is an action for trade-mark infringement and unfair competition between citizens of different states, namely, Ohio and New Hampshire.

Questions Presented

The questions presented are:

(1) The validity, as a trade-mark, of a pictorial representation of a product showing the product in use, giving pictorial directions for its use and thereby describing the character of the product.

(2) The abandonment of trade-mark rights by non-user thereof, a different trade-mark having been substituted therefor.

(3) The applicability of Section 37 of the Trade-mark Act of 1946 (United States Code Title 15 Section 1119) to actions pending on July 5, 1947, the effective date of said Act.

Reasons Relied on for the Allowance of the Writ

(1) Petitioner has ascertained that respondent The Hygienic Products Company is about to file a petition for writ of certiorari, but this cross-petition has been prepared without having seen respondent's petition. The rules of this Court state that only the questions specifically brought forward by a petition for writ of certiorari will be considered. It is not to be expected that respondent herein would, in its petition, raise any question concerning the validity of its trade-marks, the abandonment thereof or the applicability of the Trade-mark Act of 1946. Therefore, and in order that these fundamental questions may prop-

erly be brought before this Court in the event that respondent's petition is granted, this petition should also be granted.

(2) So far as can be presently ascertained, this Court has not passed specifically upon the validity of a pictorial trade-mark descriptive of the character of a product, such as is here involved, or upon the right of one producer to secure a competitive advantage over another in the use of advertising material bearing a pictorial representation of the product and the manner of its use on the theory that the former has acquired perpetual exclusive rights in such pictorial representation under the trade-mark laws. These are questions of public importance which should be settled by this Court because if one producer by adopting and using a picture mark illustrating how, where, by whom and for what purpose his product is most commonly used, can attempt to monopolize the use of such matter in advertising, then every other manufacturer of a like product will either be excluded in perpetuity from so advertising its manner of use or be compelled to defend its right to use such advertising matter, as petitioner did in this case.

(3) The law is well settled that abandonment of trade-mark rights does not necessarily follow from non-user, the determining factor being one of intention, but with the exception of one Court of Appeals case upon which petitioner relied, there does not appear to be any authoritative pronouncement upon abandonment by non-user coupled with the substitution of another and different mark in the face of the non-user's denial of any intent to abandon. Here again is an important point of trade-mark law which should have the consideration of this Court.

(4) The Trade-mark Act of 1946 provides that in any action involving a registered trade-mark, the District Court may determine the right to registration and order the cancellation of registrations if such relief is warranted. Petitioner counterclaimed for such relief. The District Court,

although finding that the trade-marks were valid, held that the 1946 Act did not apply because this case was pending when that Act went into effect. The Act in question states that "except as otherwise herein specifically provided" it shall not affect any suit, proceeding or appeal then pending, but it also says that registrations under the Act of February 20, 1905 shall be subject to the provisions of the 1946 Act to the same extent and with the same force and effect as though registered thereunder, except for certain provisions not presently involved. This presents a question of statutory construction which should have an authoritative ruling from this Court.

If this Court should issue a writ of certiorari as prayed for by The Hygienic Products Company, but which is opposed by the petitioner herein, your petitioner respectfully requests that the Court grant this cross-petition so that at least the fundamental issue in the case, namely, the validity of respondent's alleged trade-marks, may be before it and so that your petitioner will be free to urge the complete invalidity of respondent's trade-marks and the registrations thereof as it did below.

Respectfully submitted,

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March 10, 1950